

Attorney Docket No. LEAP:126US
U.S. Patent Application No. 10/721,695
Reply to Office Action of September 18, 2006
Date: October 3, 2006

Remarks/Arguments

Claim Objections

Claim 18 was objected to for reciting that the rod is directly attached to the slide mount guide. This conflicted with the requirement that the rod be directly attached to the slide mount as recited in Claim, which Claim 18 is dependent. Claim 2 has been amend to recite that the releasable attachment means is arranged to attach (not directly attach) the rod to the slide mount. Claim 18 still recites that a slide mount guide is directly connected to the slide mount, and the rod is directly attached to the slide mount guide by a releasable attachment means. Given that Claim 2 merely recites that the releasable attachment means is arranged to attach the rod to the slide mount, there is no longer a conflict between the language of Claim 2 and 18. Applicants request that the objection be withdrawn.

The Rejection of Claims 2, 3, 5, 6, 9, 10 and 16-18 Under 35 U.S.C. §102(b)

The Examiner rejected Claims 2, 3, 5, 6, 9, 10 and 16-18 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,018,415 (Woo). Applicants respectfully traverse the rejection and request reconsideration for the following reasons.

Claims 2, 3, 5, 6, 9, 10, 18 and 19

Woo fails to teach or disclose a slide mount. A slide mount is a specific structure that accomplishes a specific function because of that structure. The term as used in the art and throughout the application is defined as a structure that mounts or holds a slide on a microscope stage. Occasionally, a slide mount is called a slide clip among microscopists, but it is explicitly explained in the specification of the instant application that term “slide mount” refers to a structure that holds a slide. Paragraph [0024] reads that slide mount 16 is incorporated into the stage assembly and enables movement of slide 17 holding the specimen to be viewed. Figures 1, 2, 3 and 7 show that slide mount is not merely a structure that slides, but is a structure that holds slides such as slide 17. The slide mount recited in Claim 2 just so happens to also be capable of sliding. The name slide mount has nothing to do with the structures ability to slide, and

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everything to do with the slide mounting or holding capability.

The element that has been dubbed a slide mount is entirely incapable of acting as a slide mount. X-axis moving plate 42 is a plate with a wafer holder 41 attached. Wafer holder 41 is a structure that is not only incapable of holding a slide, it would actually cause a slide to fall off of the X-axis moving plate 42. (See Col. 5, lines 13-17). Therefore, Woo fails to teach all the limitations of Claim 2 and that claim is novel.

Moreover, Woo fails to teach a rod that is attached to a slide mount by a releasable attachment means. Claim 2 specifically limits the attachment means to a releasable attachment means in order to make the rod releasably attached. Woo does not teach or suggest this limitation. Woo has joystick 43 FIXED to X-axis moving plate 42 of the X-Y table 40. (See Col. 5, lines 5-10)

Lastly, the Y-axis connecting rods 45 that have been analogized to an upper stage are not an upper stage as one of ordinary skill in the art would understand the term. A microscope stage is not merely any feature or structure that is on a microscope, but is a structure that serves a specific function, with specific identifying structural features. A microscope stage is universally described as a small platform on a microscope where a specimen is mounted for examination. Applicants are unaware of any other definition for a microscope stage and submit that connecting rods 45 would never be analogized to an upper stage by those of skill in the art. There is no way that a specimen could ever be mounted to connecting rods 45 for examination. Connecting rods are positioned and shaped to serve one purpose, hold Y-axis moving plates 44 together. The Examiner also states that connecting rods 45 are connected to both the X-axis moving plate and the Y-axis moving plates, so the upper stage must move in the X and Y direction. However, careful inspection of the application reveals that connecting rods 45 are positioned on opposite sides of fixed plate 46 and prevent connecting rods 45 and Y-axis moving plate from moving in any direction other than in the Y-direction. (See Figure 6, and Col. 5, lines 20-40) Also, connecting rods 45 are not on the upper portion of the Woo assembly, but are at the bottom of the assembly, and for this reason Applicants are confused as to how the Examiner has analogized connecting rods 45 to an upper stage. Therefore, Woo fails to teach the upper stage of

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Claim 2.

Consequently, because Woo fails to teach all the limitations of Claim 2 that are addressed above, Claim 2 is novel. Claims 3, 5, 6, 9, 10, 18 and 19 are dependent on Claim 2 and due to that dependency are also novel and patentable. Applicants request reconsideration and withdrawal of the rejection of Claims 2, 3, 5, 6, 9, 10 and 18 in light of the arguments and amendments presented above.

Claims 16 and 20

Claim 16 now recites that the shaft is releasably attached to a slide mount guide that is attached to the slide mount. As was pointed out above, joystick 43 disclosed by Woo is not attached by a releasable attachment means. Neither is joystick 43 releasably attached to a slide mount guide that is attached to a slide mount. Assuming *arguendo* that X-axis moving plate 42 is a slide mount, which it is not, joystick 43 is not analogous to the shaft of Claim 16 because it is **fixedly attached** to X-axis moving plate 42. No releasable attachment means is taught or disclosed. Furthermore, the current claims include the limitation that the shaft is releasably attached to a slide mount guide that is attached to a slide mount. Woo does not describe an arrangement where a shaft is attached (and definitely not releasably attached) to a slide mount guide which is then attached to a slide mount. Woo only discloses a joystick 43 that is fixedly attached to the bottom of the X-axis moving plate 42. No releasable connection is taught or disclosed. No slide mount guide is taught or disclosed.

Moreover, the shaft in Claim 16 is attachable to the slide mount guide to operatively position said shaft on the left or right side of said upper stage. Woo teaches or discloses a joystick 43 that is fixed to one position on the bottom side of X-axis plate 42. The joystick taught or disclosed by Woo is not positionable at any other location other than the right side of X-axis plate 42. Thus, Woo fails to teach or disclose all the limitations of Claim 16.

For the reasons explained above, Claim 16 is patentable and Claim 20 that is dependent on Claim 16 is also patentable. Applicants request reconsideration and withdrawal of the rejection of Claims 16 and 20 in light of the arguments and amendments presented above.

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Claim 17

Claim 17 recites that the joystick is secured directly to a slide mount guide, which is connected to a slide mount. Also, the joystick is secured to the slide mount guide to operatively position said joystick on the left or right side of said upper stage. Woo fails to teach a joystick that is secured to a slide mount guide. Neither does Woo teach that the joystick can be positioned on the left or right side of an upper stage. Woo teaches or discloses a joystick fixed to the bottom of X-axis plate 42 in one arrangement. Joystick 43 taught and disclosed by Woo can not be repositioned to be on the left or right side of X-axis plate 42 because it is fixedly attached and positioned on only the right side of X-axis plate 42. Therefore, Claim 17 is novel and patentable. Claim 21, which is dependent on Claim 17, is also novel and patentable due to that dependency.

Claims 19, 20 and 21

Claims 19 20 and 21 are novel and patentable based on their dependency on independent claims that are patentable, but also due to the novel and unobvious positioning of the slide mount guide between the upper stage and the slide mount. This limitation is also not taught or disclosed by Woo. Since Woo doesn't teach a slide mount guide, it can not teach a slide mount guide positioned between the upper stage and the slide mount. Therefore, Claims 19, 20 and 21 are novel and patentable and Applicants request reconsideration and withdrawal of the rejection of those claims.

The Rejection of Claims 3, 9 and 10 Under 35 U.S.C. §103(a)

Claims 3, 9 and 10 were rejected Under 35 U.S.C. §103(a) as being unpatentable over Woo in view of U.S. Patent No. 6,049,420 (Kraft). Applicants respectfully traverse this rejection.

Applicants have shown that Woo fails to teach all the elements of Claim 2. (See arguments *supra*). Furthermore, Kraft does not cure the defects of Woo regarding the elements of Claim 2 that are not taught or disclosed by Woo. Therefore, Claim 3, 9 and 10 are patentable over the combination of Woo and Kraft due to the patentability of Claim 2 over that same combination. Applicants request reconsideration of the rejection of Claims 3, 9 and 10.

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The Rejection of Claims 4, 8 and 11 Under 35 U.S.C. 103(a)

Claims 4, 8 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft in view of Ergolux B 0 1-Ersatztelliste (Leitz). Applicants respectfully traverse this rejection.

Applicants have shown that Woo fails to teach all the elements of Claim 2. (See arguments *supra*). Furthermore, Leitz does not cure the defects of Woo regarding the elements of Claim 2 that are not taught or disclosed by Woo. Therefore, Claim 4, 8 and 11 are patentable over the combination of Woo and Leitz due to the patentability of Claim 2 over that same combination. Applicants request reconsideration of the rejection of Claims 4, 8 and 11.

The Rejection of Claims 7 and 12-14 Under 35 U.S.C. 103(a)

Claims 7 and 12-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Woo in view of U.S. Patent Application No. 2003/0169492 (Nishida et al.). Applicants respectfully traverse this rejection.

Applicants have shown that Woo fails to teach all the elements of Claim 2. (See arguments *supra*). Furthermore, Nishida et al. does not cure the defects of Woo regarding the elements of Claim 2 that are not taught or disclosed by Woo. Therefore, the combination of Woo and Nishida et al. fails to teach or suggest all the limitations of Claim 2 and that claim is patentable. Claims 7 and 12-14 are dependent on Claim 2, and therefore are also patentable over the combination of Woo and Nishida et al. Applicants request reconsideration of the rejection of Claims 7 and 12-14.

The Rejection of Claim 15 under 35 U.S.C. §103(a)

Claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over Woo in view of U.S. Patent No. 5,907,157 (Yoshioka et al.). Applicants respectfully traverse this rejection.

Applicants have shown that Woo fails to teach all the elements of Claim 2. (See arguments *supra*). In addition, Yoshioka et al. does not cure the defects of Woo regarding the elements of Claim 2 that are not taught or disclosed by Woo. Therefore, the combination of Woo and Yoshioka et al. fails to teach or suggest all the limitations of Claim 15, and a *prima*

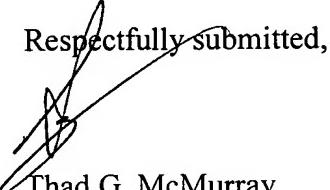
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facie case of obviousness has not been proven. Applicants request reconsideration of the rejection of Claim 15.

Conclusion

For all the reasons outlined above, Applicants respectfully submit that the claims are in condition for allowance, which action is courteously requested.

Respectfully submitted,



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